

REMARKS

In the subject office action, all of the claims were rejected under 35 USC §103(a) as being unpatentable over U.S. published application 2002/0026394 (hereinafter “Savage”) in view of U.S. Patent 6,839,687 (hereinafter “Dent”). Applicants respectfully traverse those rejections, and submit that the pending claims should be allowed in their present form. Below are set forth remarks explaining applicants’ traversals and in support of the patentability of the pending claims.

Argument 1: The Pending Claims Recite Limitations Not Taught or Suggested in the Cited Art

For a claim to be rejected under 35 U.S.C. § 103, it is necessary that a reference or combination of references teaches or suggests each limitation recited in that claim. In this case, applicants note that the independent claims (13, 27 and 40) each set forth a detailed sequence of steps which must be taken to perform the methods claimed by the inventors, and that the sequences of steps recited in those claims are not taught or suggested in either Savage, or Dent, or in the combination of those references. Regarding Savage, the applicants note that, while that reference contains multiple references to formatting a bill, it does not contain disclosure which addresses the specific limitations which are recited in the pending claims. Regarding Dent, the applicants note that the passage of that reference cited as teaching one or more limitations from the pending claims (column 10, line 26 – column 11, line 31) is related to allowing a customer to challenge items on a bill, but is simply not relevant to formatting a billing statement form as claimed. The applicants also note that the figures of Dent cited in the subject office action, figures 8-9, are shown in the context of allowing a customer to challenge line items, and similarly fail to teach or suggest the limitations of the pending claims which are absent from Dent. As a consequence, not only should the independent claims (13, 27 and 40) be allowed in their present form, but the claims which depend therefrom should be allowed as well. A claim by claim analysis of additional limitations not taught or suggested by the art of record is set forth below.

*Claim 13*

Regarding claim 13, while the applicants appreciate the Examiner's observation that Savage does not teach that attributes of a statement presentation code could comprise a section code, a summary line and a sorting indication (recited as elements (a)(i)(1)-(3)) the applicants submit that additional limitations recited in claim 13 are also not taught in Savage. For example, the applicants assert that the step of creating a plurality of statement presentation codes, said statement presentation codes having one or more attributes comprising a statement presentation section (recited as element (a)(i)(4) of claim 13), the step of "creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user" (recited as element (a)(ii) of claim 13) and the step of "assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections" (recited as element (a)(iv) of claim 13) are also not taught or suggested in Savage. The applicants additionally submit that Dent is not sufficient to remedy those deficiencies for a number of reasons. For example, regarding the limitations of "creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user," Dent actually teaches that "The bill appears according to the biller's design." Col. 3, ll. 55-56 (emphasis added). Additionally, regarding the limitations of creating a plurality of statement presentation codes having one or more attributes comprising a statement presentation section, the applicants note that not even the Office Action asserted that those limitations were found in Dent. See Office Action at 3, asserting that ("it would have been obvious to one of ordinary skill in the art at the time [of] [sic] the invention to modify the teachings of Savage to include a section code, a summary line taught by Dent"). Regarding the step of "assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections," the applicants note that Dent simply does not teach or suggest the use of statement presentation codes or that such codes might be assigned to sections. Thus, for the additional reasons that at least elements (a)(i)(4), (a)(ii) and (a)(iv) from claim 13 are neither taught nor suggested in either Dent or Savage, the pending rejections should be withdrawn, and claim 13 should be allowed.

*Claims 15-21 and 23-25*

Regarding claims 15-21 and 23-25, the applicants note that those claims each depend, directly or indirectly, from claim 13, and thereby incorporate by reference each limitation recited in claim 13. Additionally, the applicants note that claims 15 and 16 were simply omitted from the Office Action and that, consequently, no prima facie case of obviousness could possibly have been made out for either of those claims. Thus, the rejections of claims 15-21 and 23-25 should be withdrawn, and those claims should be allowed in their present form.

*Claim 27*

Regarding claim 27, while the applicants appreciate the Examiner's observation that Savage does not teach creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment (recited as elements (a)(iii)(1)-(4)), the applicants submit that additional limitations recited in claim 27 are also not taught in Savage. For example, the steps of "creating a plurality of statement presentation codes, each statement presentation code comprising one or more attributes for dictating the presentation of transaction information on a customer billing statement" (recited as element (a)(i) of claim 27), "creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user" (recited as element (a)(ii) of claim 27), "assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections" (recited as element (a)(iv) of claim 27), and "entering billing information relating to a plurality of services provided to said customer into said formatted billing statement form in accordance with said segments, said sections, said statement presentation codes, and said input to create one or more completed billing statements" (recited as element (b) from claim 27) are also not taught in Savage. The applicants additionally submit that Dent is not sufficient to remedy those deficiencies for a number of reasons. Regarding the steps of "creating a plurality of statement presentation codes, each statement presentation code comprising one or more attributes for dictating the presentation of transaction information on a customer billing statement," "assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections", and "entering billing information relating to a plurality of services provided to said customer into said formatted billing statement form in accordance with said segments, said sections, said

statement presentation codes, and said input to create one or more completed billing statements” as set forth above regarding claim 13, Dent simply does not teach or suggest the use of statement presentation codes, and therefore can not teach or suggest those limitations. Regarding the step of “creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user,” as set forth regarding claim 13, Dent teaches that the biller, not the user, determines the presentation of a billing statement, and so does not teach or suggest that the user can select statement presentation codes. Thus, for the additional reasons that at least elements (a)(i)-(ii), (a)(iv) and (c) from claim 27 are not taught or suggested in the art of record, the applicants request that the rejection of claim 27 be withdrawn, and that that claim be allowed.

*Claims 28-29, 31-34, and 36-39*

Regarding claims 28-29, 31-34, and 36-39, the applicants note that those claims each depend, directly or indirectly, from claim 27, and thereby incorporate by reference each limitation recited in claim 27. Thus, the rejections of claims 28-29, 31-34 and 36-39 should be withdrawn, and those claims should be allowed in their present form.

*Claim 40*

Regarding claim 40, the applicants note that at least the limitations of “creating a plurality of statement presentation codes, each statement presentation code comprising one or more attributes for dictating the presentation of transaction information on a customer billing statement” (recited as element (a)(i) of claim 40), “creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user” (recited as element (a)(ii) of claim 40), “assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections” (recited as element (a)(iv) of claim 40), “entering billing information relating to a plurality of communications services provided to a customer into said formatted billing statement form in accordance with said segments, said sections, and said statement presentation codes to create one or more statement export files” (recited as element (b) of claim 40), “grouping together information relating to a plurality of communications services into at least one of said segments or at least one of said sections” (recited as element (e) of claim 40), and “assigning a

statement attribute code to each communications service to represent how said information is to be grouped together” (recited as element (f) of claim 40) are not taught or suggested in Savage. Additionally, the applicants note that Dent is insufficient to remedy the deficiencies of Savage for a number of reasons. Regarding the limitations of “creating a plurality of statement presentation codes, each statement presentation code comprising one or more attributes for dictating the presentation of transaction information on a customer billing statement”, “assigning at least one statement presentation code from said plurality of statement presentation codes to at least one section from said plurality of sections”, and “entering billing information relating to a plurality of communications services provided to a customer into said formatted billing statement form in accordance with said segments, said sections, and said statement presentation codes to create one or more statement export files”, the applicants note that, as set forth previously, Dent simply does not teach the use of statement presentation codes, and therefore does not teach or suggest any of those limitations. Regarding the limitations of “creating a plurality of user-selected sections, each section having at least one of said statement presentation codes being selected by a user”, as set forth above, Dent teaches that the biller, not the user, determines the appearance of a bill, and accordingly does not teach or suggest those limitations. Regarding the limitations of “assigning a statement attribute code to each communications service to represent how said information is to be grouped together”, Dent does not teach the use of codes to group information, let alone the use and assignment of statement attribute codes as recited in claim 40, and accordingly does not teach those limitations. Thus, for the additional reasons that at least elements (a)(i)-(ii), (a)(iv), (b), (e) and (f) are not taught or suggested in either Savage or Dent, the rejection of claim 40 should be withdrawn, and that claim should be allowed in its present form.

*Claims 41-47 and 50-52*

Regarding claims 41-47 and 50-52, the applicants note that those claims each depend, directly or indirectly, from claim 40, and thereby incorporate by reference each limitation recited in claim 40. Thus, the rejections of claims 41-47 and 50-52 should be withdrawn, and those claims should be allowed in their present form.

Argument 2: No Motivation to Modify or Combine the Cited References Has Been Provided

For a claim to be rejected under 35 U.S.C. § 103, even if all limitations recited in that claim are taught or suggested in a combination of references, it is necessary for the Examiner to show that some teaching, suggestion or motivation existed in the prior art to combine the cited references to obtain the invention claimed. MPEP 2143.01. In this case, while the Office Action conceded that not all limitations from the pending claims are taught in Savage, it did not provide a teaching, suggestion or motivation to modify Savage, either by combining it with the teachings of Dent, or by altering the features already present in Savage, to achieve the invention recited in the pending claims. For example, in rejecting claim 27, the subject office action stated that

Savage fail [sic] to explicitly teach [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment.

However, Dent discloses a graphical user interface window containing an electronic billing statement presented by the payment analyzer on display. The billing statement is for a fictitious company Crown Home Improvement Center. The bill has a main body portion that lists individual line items for each purchase at Crown Home Improvement Center, with each line item containing the purchase date, purchase order number, invoice number, item number, description of item, quantity, price, total, tax, and amount due. (See Fig 8-9 and column 10 lines 26-67 and column 11 lines 1-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time [sic] the invention to modify the teachings of Savage to include [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment taught by Dent in order to display [sic] bill statement with [sic] a creating a summary segment, creating an itemization segment, creating a usage detail segment, and creating a tax segment.

Such a laundry list, followed by a broad, conclusory statement that “it would have been obvious” is representative of the justifications provided for combining Savage and Dent, and is insufficient as a matter of law for making out a prima facie case of obviousness. Thus, the obviousness rejections of the pending claims based on Savage in view of Dent should be withdrawn, and the claims rejected based on that combination should be allowed in their present form.

General Remarks

While the applicants believe that the remarks set forth above are clearly sufficient to establish the patentability of the pending claims, to the extent the Examiner reaches a contrary conclusion, the applicants request that, in future actions, the Examiner clearly identify the relevant portions of Savage, or other reference, which are believed to teach the limitations recited in the claims. Applicants note that when a claim is rejected as obvious, “the pertinence of each reference, if not apparent, must be clearly explained.” 37 C.F.R. § 1.104(c)(2). In this case, rather than clearly explaining the pertinence of each reference, particularly Savage, the Office Action for all limitations supposedly taught or suggested in Savage except element (a) of claim 13, simply stated that those limitations were found in Savage, somewhere in paragraphs 13-115. This is inconsistent with both the requirements of 37 C.F.R. § 1.104, and with the goal of the examination process to “to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP § 706. Thus, in the future, to help determine patentable subject matter contained in the present claims, or to develop a clear issue between the applicants and the examiner for appeal, the applicants respectfully request that the Examiner identify as specifically as practicable the particular portions of Savage or Dent or other references as may be cited which are believed to teach or suggest a particular claim limitation.

The applicants submit that the above discussion does not constitute an exhaustive list of the novel limitations found in the pending claims which are not taught or suggested in the art of record. To the extent that the applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Similarly, while the remarks set forth herein have addressed the rejections over Savage in view of Dent, these remarks should not be construed as admissions of the prior art status of either of those references. Indeed, the applicants reserve all rights with respect to arguments not explicitly raised herein. Further, to the extent the Examiner believes that there are amendments which, if made, would allow one or more claims to issue, the applicants respectfully request that the Examiner suggest such amendments because, while the examiner has the duty to only allow valid claims, “the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.” MPEP § 706.

Conclusion

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. § 103(a). Accordingly, reconsideration and allowance of these claims are earnestly solicited. Applicants encourage the Examiner to contact their representative, Ria Schalnatz at (513) 651-6426 or [rschalnat@fbtlaw.com](mailto:rschalnat@fbtlaw.com) if any issues remain as to the patentability of one or more of the pending claims.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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